

### **REMARKS**

Claims 1-4, 6-19 remain in the application, claim 5 having been canceled. Independent claims 1 has been amended to include the limitations of the thermal interface material comprising polycaprolactone. Support for this amendment can be found in paragraph 20 of the present application, for example. Claims 2-9, 12, 15 have been amended for clarity. No new subject matter has been added with these amendments.

#### **A. 35 U.S.C. § 102(b)**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed.Cir.1989).

#### **Kang- Claims 1-8, 10-13, 18-19**

Claims 1-8, 10-13, 18-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the U.S. Patent issued to Kang, et al. (hereinafter “Kang”) (Office Action, page 2). Independent claim 1 has been amended to include the TIM comprising polycaprolactone. Since Kang does not teach or suggest a TIM comprising polycaprolactone, it is respectfully submitted that claim 1 is not anticipated by Kang. Since the dependent claims are not anticipated for at least the reasons the independent claims from which they depend are not anticipated, the dependent claims will not be argued at this time. Thus, reconsideration and withdrawal of the Section 102(b) rejection of claims 1-8, 10-13, 18-19 is respectfully requested.

B. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Kang-Claim 9

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kang. The Office contends it would have been obvious (to which the Applicants do not concede) to have thermal conductivity greater than 50 W/mK.

However, independent claim 1 has been amended to include the limitations described above. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Because Kang does not teach nor even suggest the limitations of amended claim 1, from which claim 9 depends, claim 9 is not rendered obvious by Kang, and thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 9 is respectfully requested.

Kang in view of Ross-claims 14, 16

Claims 14, 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kang in view of Ross. The Office contends it would have been obvious (to which the Applicants do not concede) to employ the clay of Ross in the Kang package.

However, independent claim 1 has been amended to include the limitations described above. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Because neither Kang nor Ross not teach or even suggest the limitations of amended claim 1, from which claims 14, 16 depend, claims 14, 16 are not rendered obvious by Kang in view of Ross, and thus, reconsideration and withdrawal of the Section 103(a) rejection of claims 14, 16 is respectfully requested.

Kang in view of Ross, further Furuya-claims 15, 17

Claims 15, 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kang in view of Ross, and further Furuya. The Office contends it would have been obvious (to which the Applicants do not concede) to employ the teachings of Furuya in the package of Ross and Kang.

However, independent claim 1 has been amended to include the limitations described above. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Because neither Kang nor Ross not teach or even suggest the limitations of amended claim 1, from which claims 15, 17 depend, claims 15, 17 are not rendered obvious by Kang in view of Ross, and thus, reconsideration and withdrawal of the Section 103(a) rejection of claims 15, 17 is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to

contact the below-signed Attorney to further the prosecution of the application, the contact number is (480) 715-5448.

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Respectfully submitted,  
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